

REMARKS

This filing is made in Response to the Office Action of May 15, 2007, in view of the Advisory Action of September 4, 2007. In that Advisory Action, the Examiner made no indication as to whether or not the claim amendments presented in the Response of August 14, 2007 were entered.

Therefore, this filing presumes that the claim amendments presented in the response of August 14, 2007 were entered, but that all of the previous rejections and indications of allowability stand. Thus, claims 17 and 21 – 24 remain allowed, claims 1, 4 -8, 11 – 14, 16, and 18 -20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5, 150,458 to Masuzaki et al. (hereinafter referred to as “Masuzaki et al.”) in view of U.S. Patent No. 5,732,230 to Cullen et al. (hereinafter referred to as “Cullen et al.”); and claim 15 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Masuzaki et al. in view of Cullen et al. and in view of U.S. Patent No. 5,959,867 to Speciner et al. (hereinafter referred to as “Speciner et al.”).

By this Response and Amendment, claims 1, 5, 7, 8, 12, 14, 15, 17, 18, and 20 – 24 are amended, and claims 4, 6, 11, 13, 16, and 19 are cancelled without prejudice or disclaimer. Applicant reserves the right to pursue these cancelled claims in one or more continuing applications.

Claims 2, 3, 9, and 10 were previously cancelled.

Accordingly, claims 1, 5, 7, 8, 12, 14, 15, 17, 18, and 20 – 24 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks, and new claims 25 – 40 are newly presented for a first action on the merits.

As 3 independent claims and 20 total claims were originally paid for, and as 15 independent claims and 30 total claims are presented herewith, a check including the amount of \$3,020 for Excess claims fees as a non-small entity under 37 CFR 1.16 (h) and (i) accompanies this response.

It is respectfully submitted that the above amendments do not introduce any new matter to this application within the meaning of 35 U.S.C. §132.

Support for the amendments to the pending claims may be found in the specification as originally filed, including *inter alia* in Figure 7, in which images to be combined are divided into a plurality of monochromatic image files such as input data file 1 and input data file 2, and thus two original monochromatic image files 1 and 2 are displayed on the display section 20 and each of the two files 1 and 2 includes a plurality of image pages such as image pages 21a, 21b, ..., 21f in file 1.

Support for the new claims may be found in the previous claims, as follows:

Claims 25 adds features of claim 17 to currently amended claim 1, claim 26 adds features of claim 17 to currently amended claim 8; and claims 27 and 28 add features of claims 21 and 22 to currently amended claim 8.

Claim 29 adds features from claims 4 and 17 to a previous form of claim 1. Claim 30 adds features from claims 4 and 21 to a previous form of claim 1. Claim 31 adds features from claims 4 and 22 to a previous form of claim 1.

Claim 32 adds features from claim 17 to a previous form of claim 1. Claim 33 adds features from claims 11 and 17 to a previous form of claim 8. Claim 34 adds features from claims 11 and 21 to a previous form of claim 8. Claim 35 adds features from claims 11 and 22 to a previous form of claim 8. Claim 36 adds features from claim 17 to a previous form of claim 8. Claim 37 adds features from claims 16 and 17 to a previous form of claim 15. Claim 38 adds features from claims 16 and

23 to a previous form of claim 15. Claim 39 adds features from claims 16 and 24 to a previous form of claim 15. Claim 40 adds features from claim 17 to a previous form of claim 15.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 4 -8, 11 – 14, 16, and 18 -20 as being unpatentable over Masuzaki et al. in view of Cullen et al.; and claim 15 was rejected as being unpatentable over Masuzaki et al. in view of Cullen et al. and in view of Speciner et al.

Response

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Applicant respectfully traverses the Examiner's rejections since all of the features of the presently claimed invention are not disclosed, taught or suggested in the cited prior art.

Amended independent claims 1 and 8 recite, *inter alia*, “a plurality of original monochromatic image files for output, *each of the plurality of original monochromatic image files including a plurality of image pages* formed from characters and images.” (Emphases added)

As noted above, support for these claims may be found *inter alia* in Figure 7, where images to be combined are divided into a plurality of monochromatic image files such as input data file 1 and input data file 2. Two original monochromatic image files 1 and 2 are displayed on the display

section 20 and each of two files 1 and 2 includes a plurality of image pages such as image pages 21a, 21b, ..., 21f in file 1. Image pages to be combined are selected from different kinds of monochromatic image files. For example, in the present invention, user can combine page 21a of file 1 and page 22a of file 2 on the display section 20. Therefore, as recited in the present claims, the image formation apparatus of the present invention combines a plurality of original monochromatic image files in page units.

Masuzaki et al. discloses an electronic image information filing apparatus displaying editing corrections. Masuzaki does not show a plurality of original monochromatic image files, each of which includes a plurality of image pages. The Examiner admits that Masuzaki et al. fails to teach or suggest all of the features of the independent claim 1 and 8, and cites Cullen et al. in an attempt to cure the deficiencies of Masuzaki et al.

Cullen et al. teaches a computer user interface for manipulating image fragments using drag, drop and merge operations. As shown in Fig.5 of Cullen, several segments of a map are displayed on the display section (user interface) 340. However, Applicants traverse any interpretation that the segments are selected from different kinds of monochromatic image files. Fig. 5 of Cullen provides no support for any interpretation in which the map segments of Cullen are parts of a single kind of file or "map". Further, Cullen gives no indication that the apparatus of Cullen combines the plurality of monochromatic image files in page units.

Thus, the combination of references does not render the presently claimed invention obvious.

Moreover, as claims 5, 7, 12, 14, 23 and 24 depend from one of independent claims 1 or 8, these claims are believed to be allowable for at least similar reasons.

Similarly, amended independent claim 15 recites “selecting a plurality of desired original monochromatic image files from among *a plurality of original monochromatic image files for output, the plurality of original monochromatic image files including a plurality of image pages* formed from characters and images...”

Regarding claim 15, Speciner et al. teaches a computer system and process for efficient processing of a page description using a display list. The Examiner asserts that both the spooling and rasterizing of images are conventional in the art as taught by Speciner et al.

The arguments above with respect to Masuzaki et al. and Cullen et al. are incorporated by reference. Even assuming *arguendo* that the Examiner is correct regarding Speciner et al., the reference fails to cure the deficiencies of Masuzaki et al. and Cullen et al. regarding the features discussed above, as present in independent claim 15..

Moreover, as claims 17, 18, 20, 23, and 24 depend from independent claim 15 these claims are believed to be allowable for at least similar reasons.

Thus, none of the cited references individually or in combination render the presently claimed invention obvious.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a).

ALLOWABLE CLAIMS

Claims 17 and 21 – 24 continue to be allowed. Applicant thanks the Examiner for the indication of allowable subject matter.

In accordance with the Examiner's indication of allowable subject matter, Applicant presents herewith new claims 25 – 28. Claim 25 adds features of allowable claim 17 to currently amended claim 1, claim 26 adds features of allowable claim 17 to currently amended claim 8; and claims 27 and 28 add features of allowable claims 21 and 22 to currently amended claim 8.

Therefore, claims 25 – 28 are believed to be allowable at least for the same reason that claims 17, 21, and 22 were deemed allowable previously.

Similarly, claim 29 adds features from claim 4 and allowable claim 17 to a previous form of claim 1. Claim 30 adds features from claims 4 and allowable claim 21 to a previous form of claim 1. Claim 31 adds features from claims 4 and allowable 22 to a previous form of claim 1.

Therefore, claims 29 – 31 are believed to be allowable at least for the same reason that claims 17, 21, and 22 were deemed allowable previously.

Further, claim 32 adds features from allowable claim 17 to a previous form of claim 1. Claim 33 adds features from claim 11 and allowable claim 17 to a previous form of claim 8. Claim 34 adds features from claim 11 and allowable claim 21 to a previous form of claim 8. Claim 35 adds features from claims 11 and allowable 22 to a previous form of claim 8. Claim 36 adds features from allowable claim 17 to a previous form of claim 8. Claim 37 adds features from claim 16 and allowable claim 17 to a previous form of claim 15. Claim 38 adds features from claim 16 and allowable claim 23 to a previous form of claim 15. Claim 39 adds features from claim 16 and allowable claim 24 to a previous form of claim 15. Claim 40 adds features from allowable claim 17 to a previous form of claim 15.

Therefore, claims 32 – 40 are believed to be allowable at least for the same reason that claims 17 and 21– 24 were deemed allowable previously.

Appl. No. 09/985,682
Atty. Docket No. 24823
Reply to Office Action of May 15, 2007
in view of Advisory Action of September 4, 2007

CONCLUSION

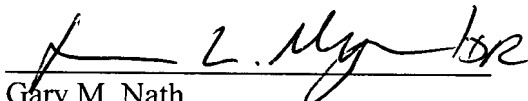
In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,
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Date: October 15, 2007
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